

**AMENDMENTS TO THE DRAWINGS**

The attached sheet of drawings includes changes to Figure 9. No new matter has been added.

Attachment: Replacement sheet

### **REMARKS**

Applicant respectfully requests the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

#### **Status of the Claims**

Claims 1 and 3-8 are pending in the application. Claims 1 and 8 have been amended herein. Support for the recitations of claims 1 and 8 can be found in the specification, *inter alia*, at page 3, line 30 to page 4, line 7; page 7, line 37 to page 8, line 3; and Figure 3. No new matter has been added. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicant respectfully requests that the Examiner withdraw all rejections and allow the currently pending claims.

#### **Drawings**

The Examiner has objected to Figure 9 for not being designated as "Prior Art." The drawings have been amended to add the legend "Prior Art."

In view of this amendment, Applicant respectfully requests removal of the outstanding objection.

#### **Issues under 35 U.S.C. § 102(b)**

The Examiner has rejected claims 1 and 8 under 35 U.S.C. § 102(b) as being anticipated by Yoichiro et al. '400 (JP-11-176400). Applicant respectfully asserts that Yoichiro et al. '400 do not disclose each and every element of independent claims 1 and 8. Therefore, Yoichiro et al. '400 do not anticipate or render obvious claims 1 and 8.

As amended, independent claim 8 recites, *inter alia*, that "either one selected from the first case body and the second case body comprises a dish-shaped case element with a housing portion swelling from one surface and a reinforcing frame fixed to the disk-shaped case element along a circumference of a swelling wall of the housing portion." Claim 1 contains a limitation that is substantially similar. Because of this element, the present invention exerts the following

effects: the structural strength of a battery can be increased while the total thickness of the battery can be reduced.

In stark contrast, Yoichiro et al. '400 do not describe this element. That is, in the battery described in Yoichiro et al. '400, thick resin frames (2c, 3c) are provided on both an upper case (2) and a lower case (3) so that the total thickness of the battery increases, which makes it impossible to reduce the thickness of the battery. Furthermore, Figure 3 of Yoichiro et al. '400 shows an example in which reinforcing portions (2b, 3b) of the upper and lower cases (2, 3) swell outward. According to this structure as well, the total thickness of the battery increases, which makes it impossible to reduce the thickness of the battery.

Furthermore, in Yoichiro et al. '400, the upper case (2) and the lower case (3) are connected via the resin frames (2c, 3c), and according to this connection method, the increase in thickness of the battery cannot be avoided.

In contrast, according to the present invention, the connection walls made of a metal thin plate are connected to each other so that the increase in total thickness of the battery can be avoided.

In addition, as amended, independent claims 1 and 8 also recite, *inter alia*, that "a battery module consisting essentially of a positive electrode, a negative electrode, and a separator...is housed directly within the housing portion." That is, the battery module of the present invention corresponds to an electric generating element instead of a completed battery. Due to this element, the present invention exerts the following effects: the outer case (1) itself can also function as a housing container of the battery module (2); therefore, the number of constituent components of a battery can be decreased, and the production cost of the battery can be decreased accordingly.

In stark contrast, Yoichiro et al. '400 do not describe this element. That is, in the battery described in Yoichiro et al. '400, an electric generating element including a positive electrode, a negative electrode, and a separator is sealed in an aluminum laminate sheet container (1), and the aluminum laminate sheet container (1) is housed in a battery case including the upper case (2) and the lower case (3). Therefore, the number of constituent components of the battery increases

by the aluminum laminate container (1), which increases the production cost of the battery accordingly.

As described above, claims 1 and 8 are not anticipated by nor rendered obvious over Yoichiro et al. '400. Withdrawal of the rejection is respectfully requested.

**Issues under 35 U.S.C. § 103(a)**

1) The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Yoichiro et al. '400 and further in view of Hasegawa et al. '630 (US 6,319,630).

2) The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Yoichiro et al. '400 modified by Hasegawa et al. '630 and further in view of Kozu et al. '766 (EP 1033766).

3) The Examiner has rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Yoichiro et al. '400 modified by Hasegawa et al. '630 and further in view of Kaneda et al. '063 (WO 00/59063).

4) The Examiner has rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Yoichiro et al. '400 and further in view of Higuchi '004 (US 6,154,004).

Applicant respectfully traverses, and reconsideration and withdrawal of these rejections are respectfully requested.

**Legal Standard for Determining Prima Facie Obviousness**

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation

to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int'l Co. v. Teleflex Inc.*, 127 SCt 1727, 82 USPQ2d 1385 (U.S. 2007). The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

*Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (U.S. 1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc.*, *supra.*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

Further, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336, quoted with approval in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

Distinctions Over the Cited Art

As discussed above, Yoichiro et al. '400 do not disclose each and every aspect of claim 1, from which claims 3-7 ultimately depend. Applicant respectfully submits that the other cited references do not overcome the deficiencies of this reference.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (Sec MPEP 2143.03). As discussed above, the combination of references fails to teach or suggest all the claim limitations of independent claim 1, and those dependent thereon. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

Applicant therefore respectfully submits that claims 3-7 clearly distinguish over the cited prior art. Reconsideration and withdrawal of this rejection are respectfully requested.

**CONCLUSION**

A full and complete response has been made to all issues as cited in the Office Action. Applicant has taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicant respectfully requests that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1 and 3-8 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

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Attachments: Replacement Drawing (Figure 9)